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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,195	06/13/2001	Kelvin Brian Dickinson	J3544(C)	6049
201	7590	03/08/2006	EXAMINER	
UNILEVER INTELLECTUAL PROPERTY GROUP 700 SYLVAN AVENUE, BLDG C2 SOUTH ENGLEWOOD CLIFFS, NJ 07632-3100			GOLLAMUDI, SHARMILA S	
			ART UNIT	PAPER NUMBER
			1616	

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/880,195

Applicant(s)

DICKINSON ET AL.

Examiner

Sharmila S. Gollamudi

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,7 and 13-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,7 and 13-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

Receipt of Request for Continued Examination received on 12/2/05 is acknowledged. Claims 1, 7, 13-17 are pending in this application. Claims 2-6 and 8-12 stand cancelled.

#### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claims 1, 7, 13-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.**

The independent claims have been amended to recite “with the proviso that coconut oil is present in the hair oil in an amount of at least 60% by weight” which does not have support in the instant specification. The instant specification on page 5 provides support for glyceride fatty ester in the amount of 95:5 to 5:95; 90:10 to 10:90; and 80:20 to 20:80. Further, page 5 provides support for 60:40 of the instantly claimed oil: hydrocarbon oil. However, the instant specification does not have support for “**at least**” 60% coconut oil specifically. If applicant contends there is support, the exact page and line of said support is requested. It is noted that that examples support 60% of coconut oil.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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**Claims 1, 7, 13-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

The independent claims have been amended to recite “with the proviso that coconut oil is present in the hair oil in an amount of at least 60% by weight” which is vague and unclear. It is unclear if the proviso requires at least 60% coconut oil or the proviso only requires “at least 60% coconut oil” when coconut oil is selected from a Markush group or in a mixture of coconut, sunflower, and almond oil. With regard to claim 13, it is unclear if the claim requires 60-80% “one or more glyceride fatty esters” and at least 60% coconut oil, and 20-40% of light mineral oil, which is indefinite since this would yield components in a weight percent over 100, or is the claim referring to when the oily component that contains the glyceride fatty esters is coconut oil, it must be a weight percent of at least 60. Further clarification is requested. For purposes of applying prior art, the examiner interprets the proviso claim only to apply when the oily material is coconut oil.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 1, 7, and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 564551 in view of EP 0546235 in further view of Brown et al (5,422,118).**

GB 564551 discloses hair oil wherein the hair oil comprises a non-drying vegetable oil such as almond oil, castor oil, and sesame oil and any desired proportion of ethyl oleate. See column 1, lines 15-20. GB '551 teaches the use of oils are too greasy for use in hair preparation but the use of ethyl oleate dilutes vegetable oil which are normally too viscous, sticky, and greasy when used alone. See column 2, lines 65-75. For instance, the composition may comprise 60% almond oil and 40% ethyl oleate. With regard to claim 7, note almond oil contains glyceride fatty esters.

EP teaches a hair-restorer containing a mixture of castor oil, almond oil, olive oil, and coconut oil in equal proportions for application to the scalp. EP teaches the use of the vegetable oils lies in the fact that vegetable oils are fatty acid glycerol esters. See page 3. Glycerol and/or paraffin oil (liquid paraffin or Vaseline oil) may be added. Paraffin oil is taught as a diluent for the active substances contained in the vegetable oils. See abstract and page 5. The hair-restorer stops hair loss, stimulates the growth of strong healthy hair and cares for protects the scalp. See page 3, lines 3-7. The example teaches 1/6 parts of each castor oil, almond oil, olive oil, coconut oil, glycerol, and 16% paraffin (liquid paraffin or Vaseline oil). See page 5, third paragraph.

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Brown teaches a transdermal administration of amines. Brown teaches examples of suitable solvents include mineral oil, and fatty esters including but not limited to isopropyl myristate, isopropyl oleate, ethyl oleate, etc. See column 12, lines 14-26.

It would have been obvious for one of ordinary skill in the art at the time the invention was made to combine the teachings of GB '551 and EP '235 and substitute GB '551's ethyl oleate with the instant mineral oil. Firstly, one would have been motivated to do so with the expectation of similar results since GB '551 teaches the use of ethyl oleate to dilute vegetable oil to provide a composition that is not sticky and viscous and EP '235 teaches the use of paraffin oil to dilute the vegetable oils in a hair oil composition. Secondly, Brown teaches both mineral oil (another name for paraffin oil) and ethyl oleate act as solvents. Therefore, it would have prima facie to substitute solvent for another solvent.

With regard to the instantly recitation of the mineral oil viscosity, it is considered obvious for a skilled artisan to utilize the mineral oil of choice depending on the desired viscosity. For instance, if one wanted to increase the viscosity, one would use heavy mineral oil. Conversely, if one wanted to have a low viscosity composition, one would utilize light mineral oil. Therefore, a skilled artisan would have been motivated to utilize light mineral oil if one desired a low viscosity hair oil. It should be also noted that EP's liquid paraffin is another name for mineral oil (note page 422 of Grant & Hackh's Chemical Dictionary). Liquid paraffin has 10 to 18 carbons (note page 436 of Grant & Hackh's Chemical Dictionary) and light oils (hydrocarbons) are considered to have C12 to C20. Therefore, since EP teaches a liquid paraffin oil (carbon atoms of 10-18) and applicant claims a light mineral oil with 6-16 carbon atoms (straight chained) or 6-20 carbon atoms (branched), it is the examiner's position that EP would have a similar viscosity.

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Note the art of interest: Grant & Hackh's Chemical Dictionary, Fifth Edition, 1987, pages 422 and 436.

**Claims 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 1035855 entire document or optionally in view of Pavlin (5,998,570).**

DE teaches hair oil containing 50% olive oil, 40% paraffin oil, 9% isopropylmyristate, 0.5% N-acetylcysteine isopropylester, and 0.5% N-salicylic methionine isopropylester. It should be noted the terminology hair oil, is an implicit disclosure of the instant methodology. It should be noted that olive oil inherently contains "one or more glyceride fatty acid esters".

DE does not teach the instant 60% of the first oily component or the viscosity of the paraffin oil.

Pavlin teaches personal care products with a clear carrier. Pavlin teaches the state of the art where there is a preference for transparent formulations. See column 1, lines 53-55. Further, Pavlin teaches the use of mineral oil and the preference for light mineral oil since it is less viscous than heavy mineral oil, colorless and transparent. See column 15, lines 45-65.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to manipulate the parameters of the prior art and utilize 60% of the instant oil. One would have been motivated to do so as part of the routine experimentation process to find to the optimal working range. Generally differences in concentrations does not support patentability of subject matter encompassed by the prior art absent the unexpectedness of the ranges. Moreover, it is considered obvious for a skilled artisan to utilize the mineral oil of choice depending on the desired viscosity. For instance, if one wanted to increase the viscosity, one would use heavy

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mineral oil. Conversely, if one wanted to have a low viscosity composition, one would utilize light mineral oil.

Secondly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further look are the teaching of Pavlin and utilize the instant light mineral oil. One would have been motivated to use light mineral oil versus heavy mineral oil since light mineral oil is less viscous, colorless, and transparent as taught by Pavlin. Thus, a skilled artisan would have been motivated to use light mineral oil not only if he/she desired a low viscosity composition, but also for its colorless property. It is the examiner's position that the light mineral oil taught by Pavlin would have the instantly claimed viscosity. Assuming arguendo that it does not, it would have been obvious to utilize the appropriate light mineral oil with the desired viscosity depending on the desired overall viscosity of the composition.

With regard to the consisting essentially language, note MPEP 211.03 wherein the MPEP states "For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355 ("PPG could have defined the scope of the phrase consisting essentially of" for purposes of its patent by making clear in its specification what it regarded as constituting a material change in the basic and novel characteristics of the invention."). See also *AK Steel Corp. v. Sollac*, 344 F.3d 1234, 1240-41, 68 USPQ2d 1280, 1283-84 (Fed. Cir. 2003)."

***Response to Arguments***



Applicant argues that DE 1035855 does not teach hair oils containing high levels of coconut oil as required by the subject claims, the undesirably greasy feel associated with compositions containing high levels of coconut oil, or the addition of low viscosity hydrocarbon oils as a means of reducing greasy feel and improving the sensory characteristics of compositions with a high coconut oil content. Applicant argues Pavlin does not cure this deficiency.

Applicant's arguments filed 12/2/05 have been fully considered but they are not persuasive. Firstly, the examiner points out that the instant claims have been rejected under indefiniteness. Independent claim 13 is directed to a 60-80% first oily component that contains one or more glyceride fatty esters and 20-40% light mineral oil. Thus, the claims may be interpreted that when the oil is coconut oil, it must be in a range of at least 60% but if the oily component containing glyceride of fatty esters is chosen from another oil such as olive oil, then the proviso does not apply. Therefore, DE teaches 50% olive oil, which inherently contains glyceride fatty acid esters and it is the examiner's position that the manipulation of the concentration is obvious absent evidence of unexpectedness.

**Claims 1 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 1035855 entire document optionally in view of Pavlin (5,998,570) in further view of GB 564551.**

As set forth above, DE teaches hair oil containing 50% olive oil, 40% paraffin oil, 9% isopropylmyristate, 0.5% N-acetylcysteine isopropylester, and 0.5% N-salicylic methionine isopropylester. Pavlin teaches the use of mineral oil and the preference for light mineral oil since it is less viscous than heavy mineral oil, colorless and transparent. See column 15, lines 45-65.

DE does not teach the instantly claimed oils in independent claim 1.

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GB 564551 discloses hair oil wherein the hair oil comprises a non-drying vegetable oil such as almond oil, olive oil, castor oil, and sesame oil and any desired proportion of ethyl oleate. See column 1, lines 15-20. GB '551 teaches the use of oils are too greasy for use in hair preparation but the use of ethyl oleate dilutes vegetable oil which are normally too viscous, sticky, and greasy when used alone. See column 2, lines 65-75.

It would have been obvious for one of ordinary skill in the art at the time the invention was made to combine the teachings of DE, optionally Pavlin, and GB '551 and substitute olive oil for the instant almond oil. One would have motivated to do so with the expectation of success since GB '551 teaches conventional non-drying hair oils utilized in the art may be selected from almond oil, sesame oil, or castor oil. Therefore, it is prima facie obvious to substitute one vegetable hair oil for another well known hair oil absent the unexpectedness of the instantly claimed hair oils.

***Request for Information Under 37 CFR 1.105***

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

In response to this requirement, please provide answers to each of the following interrogatories eliciting factual information:

In searching the prior art, the examiner has found a product on the market by the name Clinic Plus non-sticky hair oil, comprising mineral oil and coconut oil, which may anticipate the instant invention. However, the examiner cannot ascertain when this product was made

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available. If applicant is aware of any information regarding this hair oil, the examiner requests this information.

***Art of Interest***

Krishnan, Hair oil: Time for Consolidation, The Hindu, Sunday 1/21/01 is cited as art of interest. Krishnan discloses the product Clinic Plus non-sticky hair oil is a combination of coconut oil and mineral oil.

Grant & Hackh's Chemical Dictionary, Fifth Edition, 1987, pages 422 and 435-436.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharmila S. Gollamudi whose telephone number is 571-272-0614. The examiner can normally be reached on M-F (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on 571-272-0887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sharmila S. Gollamudi  
Examiner  
Art Unit 1616

